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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,766	07/22/2003	Warren M. Farnworth	2741.6US (95-0804.06/US)	6771
24247	7590	09/09/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			MAGBEE, THOMAS J	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,766	Applicant(s) FARNWORTH ET AL.	
	Examiner Thomas J. Magee	Art Unit 2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07222003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of US Patent No. 6,597,066 B1 in view of Rostoker et al., U.S. Patent No. 5,453,583. Although the conflicting claims are not identical, the claimed subject matter of the patent and the instant application are not patentably distinct from each other because of the following reasons:

The claimed subject matter of the instant application, i.e., "*a semiconductor wafer having a plurality of semiconductor devices formed thereon, comprising a plurality of metal circuits being connected to the at least one bond pad of each of the at least two semiconductor devices, the at least one metal circuit sealingly engaging the first coating on the portion of a semiconductor wafer substrate and the at least one bond pad of each of the at least two semiconductor devices,*" is already claimed in Claim 1 of U.S. Patent No. 6,597,066 B1.

Claim 1 of Patent No. 6,597,066 B1 discloses the claimed structure except for the limitation of a "*plurality of metal circuits formed thereon.*" However, since a semiconductor wafer contains a large number of semiconductor devices with a large number of leads (metal circuits) connected to bond pads, it would be obvious that "*at least one metal circuit*" is connected to at least one bond pad on the wafer portion.

Additionally, this is also disclosed by Rostoker et al. (Figure 4) wherein leads (435a,435b) are connected to bond pads (420a,420b) of die, 410, and multiple devices are contained on the wafer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the multiple leads of Rostoker et al. in Patent No. 6,597,066 B1 to form a plurality of metal circuits connected to bond pads.

Furthermore, the claimed inventions of Claims 2 and 3 are within the scope of the claimed limitations of U.S. Patent No. 6,597,066 B1.

Conclusions

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Thomas Magee**, whose telephone number is **(571) 272 1658**. The Examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM (EST). If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, **Eddie Lee**, can be reached on **(571) 272-1732**. The fax number for the organization where this application or proceeding is assigned is **(703)**


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872-9306.

Thomas Magee
August 30, 2004



EDDIE LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800